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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,598	09/27/2001	Gerhard Wennerstrom	P2870US00	9391

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918 Prince St.  
Alexandria, VA 22314

EXAMINER
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HICKS, CHARLES N

ART UNIT	PAPER NUMBER
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2424

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08/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/963,598	<b>Applicant(s)</b> WENNERSTROM ET AL.	
	<b>Examiner</b> CHARLES N. HICKS	<b>Art Unit</b> 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9, 11-15, 21, 23-26, 29, 39-41, 47-49 and 52-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 11-15, 21, 23-26, 29, 39-41, 47-49 and 52-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 5/19/2009 have been fully considered but they are not persuasive. Applicant's argument on **page 12**, that McGarrahah never discloses or even suggests earmarking "portions" of a primary program nor teaches or suggest copying "earmarked data" as an associated program data file is understood. But the examiner disagrees. On **page 1, paragraph 9** of McGarrahah, the user selected television signal includes encrypted updated content information. The downloaded advertisements and trailers "earmarked data" is stored on the set-top box for future display to the user as stated on **page 5, paragraph 48** of McGarrahah. This "earmarked" program related data is extracted and stored separately form the requested programming in the system memory displayed in **figure 5**, in the main, ROM, or storage memory storing temporary variables or other intermediate information during execution of receiving requested programming, as stated on **page 8, paragraph 84** of McGarrahah. Applicant's argument on page 14, that McGarrahah fails to disclose replacing audio data in a program is understood. But the examiner disagrees. On **page 8, paragraph 86** of McGarrahah, the system may include a compact disk reader or jukebox connected to the device bus. The software agent in **figure 2** can be implemented to substitute/replace this audio output for the requested programming audio.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 9, 11-15, 21, 23-26, 29, 39-49, and 52-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarrahan (US 2003/0026424 A1), hereinafter referred to as McGarrahan, in view of McGowan (US 2003/0018745 A1), hereinafter referred to as McGowan.

5. Regarding claim 9, McGarrahan discloses an apparatus comprising: a receiver configured to receive primary program data from a communication channel (**fig. 2-3, pg. 5, paragraphs 45-48**),

and a data processor configured: record the primary program data on a storage medium (**fig. 5, pg. 8, paragraphs 84-85**),

run a software agent arranged to identify and copy one or more portions of the primary program data that have been earmarked (**fig. 5, pg. 8, paragraphs 84-85**), store a copy of said earmarked data as an associated secondary program data file on the storage medium, wherein the primary program data and the secondary program data are stored in separate files (**fig. 1-3, pg. 3-4, paragraphs 38-39**).

McGarrahan fails to disclose subsequent to both the primary program data and the associated secondary program data having been stored on the storage medium, provide a user interface for selection of the stored primary program data, and upon the selection, retrieve the associated secondary program data for display. However McGowan discloses subsequent to both the primary program data and the associated secondary program data having been stored on the storage medium, provide a user interface for selection of the stored primary program data, and upon the selection, retrieve the associated secondary program data for display (**fig. 4-5, pg. 5, paragraphs 44-45**). Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

6. Regarding claims 11 and 23, McGarrahan discloses the apparatus wherein the software agent is configured to replace at least a portion of audio data in the secondary program data with audio data from tertiary program data received by the receiver from the communication channel (**fig. 1-3, pg. 6, paragraphs 62-63**).

7. Regarding claims 12 and 25, McGarrahan discloses the apparatus where the primary program data and secondary program data are in the form of MPEG-2 files **(fig. 1-3, pg 2-3, paragraphs 28-29).**

8. Regarding claims 13 and 26, McGarrahan discloses the apparatus where the secondary program data is of a lower resolution than that of the primary program data **(fig. 1-3, pg. 3, paragraphs 32-33).**

9. Regarding claim 14, McGarrahan discloses the apparatus wherein the apparatus comprises a set top box **(fig. 1, pg. 2, paragraph 20-21).**

10. Regarding claim 15, McGarrahan discloses the apparatus further including a display device configured to display the primary and secondary data retrieved from the storage medium **(fig. 1, pg. 2, paragraph 20).**

11. Regarding claim 21, McGarrahan discloses a method comprising: receiving primary program data from a communication channel **(fig. 2-3, pg. 5, paragraphs 45-48),**

storing the primary program data on a storage medium **(fig. 5, pg. 8, paragraphs 84-85),**

running a software application so as to identify and copy one or more\_earmarked portions of the stored primary program data (**fig. 5, pg. 8, paragraphs 84-85**),

and storing a copy of the earmarked portions as associated secondary program data file on the storage medium, wherein the primary program data and the secondary program data are stored in separate files (**fig. 1-3, pg. 3-4, paragraphs 38-39**).

McGarrahan fails to disclose subsequent to the storage of the primary program data and the associated secondary program data being complete, providing a user interface for selection of the stored primary program data, and upon the selection retrieving said secondary program data for display. However McGowan discloses subsequent to the storage of the primary program data and the associated secondary program data being complete, providing a user interface for selection of the stored primary program data, and upon the selection retrieving said secondary program data for display (**fig. 4-5, pg. 5, paragraphs 44-45**). Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

12. Regarding claim 24, McGarrahan discloses the method where the secondary program data comprises promotional material in one or more of the following forms: audio, video, pictures, text or graphics (**fig. 2-3, pg. 5, paragraphs 45-48**).

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13. Regarding claim 29, McGarrahan discloses a computer-readable medium comprising instructions that when executed by a processor causes an apparatus to: receive primary program data from a communication channel (**fig. 2-3, pg. 5, paragraphs 45-48**),

store the primary program data on a storage medium (**fig. 5, pg. 8, paragraphs 84-85**),

run a software application so as to identify and copy one or more earmarked portions of the stored primary program data, store a copy of the earmarked portions as an associated secondary program data file on the storage medium, wherein the primary program data and the secondary program data are stored in separate files (**fig. 5, pg. 8, paragraphs 84-85**),

McGarrahan fails to disclose subsequent to both the primary program data and the associated secondary program data having been stored on the storage medium, provide a user interface for selection of the stored program data, and upon selection retrieve the secondary program data for display. McGowan discloses subsequent to both the primary program data and the associated secondary program data having been stored on the storage medium, provide a user interface for selection of the stored program data, and upon selection retrieve the secondary program data for display (**fig. 4-5, pg. 5, paragraphs 44-45**). Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.



14. Regarding claims 39, 47, and 52, McGowan discloses the apparatus wherein the processor is further configured to, subsequent to the storage of the primary program data and the associated secondary program data being complete, gather information relating to the associated secondary program data and display the information **(fig. 1-3, pg. 3, paragraph 32)**.

15. Regarding claims 40, 48, and 53, McGowan discloses the apparatus wherein the processor is further configured to display an icon associated with the primary program data for which the associated secondary program data is available **(fig. 5-7, pg. 5, paragraph 44)**.

16. Regarding claims 41, and 49, McGowan discloses the apparatus wherein the processor is configured to provide the user interface for selection of program titles of the primary program data **(fig. 3-7, pg. 4, paragraphs 34-35)**.

17. Regarding claims 54, 61, and 68, McGarrah discloses a method comprising: receiving primary program data comprising a multimedia broadcast program, said primary program data further comprising earmarking data identifying a plurality of earmarked portions of the multimedia broadcast program **(fig. 2-3, pg. 1, paragraph 9, pg. 5, paragraphs 45-48 wherein advertisements and trailers "earmarked data" are**

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*broadcast, but only the advertisements and trailers appropriate for the individual customers are cached to the set-top box);*

storing the primary program data in a first data file **(fig. 1-3, pg. 3-4, paragraphs 38-39);**

based on the earmarking data, copying the plurality of earmarked portions of the multimedia broadcast program to a second data file stored separately from the first data file **(fig. 5, pg. 8, paragraphs 79-80, 84-85);**

providing a user interface that allows selection of the multimedia broadcast program and allows selection of the plurality of earmarked portions of the multimedia broadcast program **(fig. 2-5, pg. 5, paragraphs 50-51);**

receiving a selection via the user interface for one of: the multimedia broadcast program and the plurality of earmarked portions of the multimedia broadcast program **(fig. 2-5, pg. 5, paragraphs 50-51);**

and based on the selection, accessing one of: the first data file and the second data file **(fig. 2-5, pg. 5, paragraphs 50-51);**.

McGarrahan is silent in regards to disclosing based on the selection, transmitting to a display one of: the multimedia broadcast program and the plurality of earmarked portions of the multimedia broadcast program. McGowan discloses based on the selection, transmitting to a display one of: the multimedia broadcast program and the plurality of earmarked portions of the multimedia broadcast program **(fig. 5-7, pg. 5, paragraphs 44-45)**. Motivation to combine the references is due to the fact that the references deal with the distribution of primary and secondary programming to multiple

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viewers. Therefore the invention would have been obvious to one of ordinary skill in the art at the time of the invention.

18. Regarding claims 55, 62, and 69, McGarrahan discloses the method wherein copying the plurality of earmarked portions of the multimedia broadcast program to the second data file comprises replacing at least a portion of audio data in the earmarked portions of the multimedia broadcast program with a separate audio soundtrack (**fig. 2-5, pg. 8, paragraphs 84-86** *wherein the software agent of figure 2 can be implemented to substitute/replace the audio soundtrack with compact disc audio, jukebox audio, or any other downloaded temporary audio variable downloaded in the broadcast transmission*).

19. Regarding claims 56, 63, and 70, McGarrahan discloses the method wherein the separate audio soundtrack is received from a same broadcaster as the primary program data in a separate parallel broadcast (**fig. 2-5, pg. 8, paragraphs 84-86** *wherein the software agent of figure 2 can be implemented to substitute/replace the audio soundtrack with compact disc audio, jukebox audio, or any other downloaded temporary audio variable downloaded in the broadcast transmission*).

20. Regarding claims 57, 64, and 71, McGarrahan discloses the method wherein the second data file corresponds to promotional content for the multimedia broadcast program (**fig. 2-5, pg. 5, paragraph 48**).

21. Regarding claims 58, 65, and 72, McGarrahan discloses the method wherein each of the plurality of earmarked portions corresponds to a separate sub-portion of the multimedia broadcast program (**fig. 2-5, pg. 1, paragraph 9** *wherein the encrypted predetermined content transmitted with the broadcast is a sub-portion of the transmission stream*).

22. Regarding claims 59, 66, and 73, McGarrahan discloses the method wherein the first data file and the second data file are stored in a same folder in a memory (**fig. 2-5, pg. 6, paragraph 62**).

23. Regarding claims 60, 67 and 74, McGarrahan discloses the method further comprising linking the first data file and the second data file by inserting a linking identifier in a file header of at least one of the first data file and the second data file (**fig. 2-5, pg. 5, paragraph 48** *wherein the set-top box makes use of "intelligence" to select ads or trailers that relate to main viewed programming*).

### **Conclusion**

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES N. HICKS whose telephone number is (571)270-3010. The examiner can normally be reached on M-F 7:30AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CNH

/Joseph G Ustaris/  
Primary Examiner, Art Unit 2424